

REMARKS

Claims 1-7 are pending. By this Amendment, claims 1-3 are amended and claims 4 -7 are added. No new matter is presented in this Amendment.

Support for claims 4 -7 is found in at least paragraphs [0046]-[0048] of the Specification. For the following reasons, reconsideration is respectfully requested.

REJECTIONS UNDER 35 U.S.C. §101:

Claims 1-3 are rejected under 35 U.S.C. §101, because the claims are allegedly non-functional descriptive material recorded on recording medium, and therefore allegedly non-statutory. The rejection is respectfully traversed.

It is respectfully submitted that the Examiner's rejection fail to meet the prima facie burden required to reject the claims because the Examiner has merely restated a legal test for compliance with 35 U.S.C. §101 without providing the necessary underlying explanation in light of the claims as is needed to meet the prima facie burden placed on the Examiner.

In general, in order to reject a claim, there needs to be sufficient evidence and arguments of record in order to meet a prima facie burden as to put the applicant on notice of the reasons for the claim's deficiency. Such evidence is further required in order for meaningful review to be provided under the Administrative Procedures Act, 5 U.S.C. §706. Thus, as noted In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), "[t]he *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant." This duty is reinforced by the Interim Guidelines for Examiner of Patent Application for Patent Subject Matter Eligibility, p. 16 (Official Gazette November 22, 2005), which states that "[t]he burden is on the USPTO to set forth a *prima facie* case of unpatentability. Therefore if the examiner determines it is more likely than not that the claimed subject matter falls outside of the statutory categories, the examiner must provide an explanation." See, also Manual of Patent Examining Procedure, § 2106, p. 2100-10 (Rev. 5, 8th Ed.)(Aug. 2006) ("Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result.") Thus, as acknowledged by United States Patent and Trademark Office examination procedures, in order to meet this prima facie standard for rejections under 35 U.S.C. §101, the record must contain more than a mere repetition of the

legal test for compliance with 35 U.S.C. §101 and/or a conclusory statement, but an explanation for the claim's failure to meet this standard.

On page 2 of the Office Action, the Examiner sets forth a legal test for determining compliance with 35 U.S.C. §101 and in view of ANNEX IV of the Interim Guidelines for Examiner of Patent Application for Patent Subject Matter Eligibility. The Examiner concludes, without further analysis on page 2, that the "claims are non-functional descriptive material on recording medium." However, the Examiner does not refer to the claims as presented to explain this conclusion, and does set forth why any existing relationships within the recited inventions are no more than "abstract ideas, stored in a computer-readable medium." As such, the Examiner has merely restated a legal test for compliance with 35 U.S.C. §101 without providing the necessary underlying explanation in light of the claims as is needed to meet the prima facie burden.

By way of example, the Examiner does not address the functional relationships in claim 1, such as those set forth in the recited functionality of the at least one still picture group information used by the apparatus for arranging the still pictures into a number of groups, the still picture group information including a first virtual deletion information corresponding to the one still picture used by the apparatus for virtually deleting the still picture, or the at least one additional audio group information used by the apparatus for arranging at least one additional audio parts into a number of groups, the additional audio group information including second virtual deletion information used by the apparatus for virtually deleting the one or more of the additional audio parts, for example. The Examiner does not refer to any of these features, and does not provide an analysis of why such recited still picture group information used by the apparatus for arranging the still pictures into a number of groups, and such recited additional audio group information used by the apparatus for arranging at least one additional audio parts into a number of groups, are considered non-statutory under 35 U.S.C. §101. The Examiner similarly does not address the recited relationships in the remaining claims 2 and 3. As such, the record does not contain an explanation, beyond a conclusory recitation of a legal test divorced from the invention as recited in the claims, sufficient to support a prima facie rejection of claims 1-3 under 35 U.S.C. §101.

Additionally, as set forth in the Interim Guidelines for Examiner of Patent Application for Patent Subject Matter Eligibility, p. 52 and the Manuel of Patent Examining Procedure §2106.01(I), claims are considered compliant with 35 U.S.C. §101 where a stored data structure "defines structural and functional interrelationships between the data structure and the computer

software and hardware components which permit the data structure's functionality to be realized." This test reflects the understanding of patentable data structures as set forth by the Federal Circuit in In re Lowry, 32 F3d 1579, 1584, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) that, "[m]ore than mere abstractions, the data structures are specific electrical or magnetic structural elements in a memory." As such, and as distinguished from compilations of music, functional relationships between the stored data elements which are realized by an apparatus define an invention within the meaning of 35 U.S.C. §101.

Consistent with this definition of functional relationships, claim 1 recites, among other elements, at least one still picture group information used by the apparatus for arranging the still pictures into a number of groups, the still picture group information including a first virtual deletion information corresponding to the one still picture used by the apparatus for virtually deleting the still picture, and at least one additional audio group information used by the apparatus for arranging at least one additional audio parts into a number of groups, the additional audio group information including second virtual deletion information used by the apparatus for virtually deleting the one or more of the additional audio parts. As such, claim 1 recites a substantive functional relationship between the elements. Therefore, it is respectfully submitted that claim 1 remains compliant with 35 U.S.C. §101.

However, in order to re-emphasize the functional relationships, claims 1-3 have been amended without narrowing the scope thereof.

Claims 2 and 3 are deemed compliant with 35 U.S.C. §101 for at least similar reasons.

REJECTIONS UNDER 35 U.S.C. §102:

Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by Oguro et al. (U.S. Patent 6,301,430). The rejection is respectfully traversed.

It is respectfully submitted that Oguro fails to disclose or suggest, a still picture group information including a first virtual deletion information corresponding to the one still picture used by the apparatus for virtually deleting the still picture, and an additional audio group information including second virtual deletion information used by the apparatus for virtually deleting the one or more of the additional audio parts, as recited in claim 1.

Instead, Oguro discloses a recording format of a video tape recorder (VTR) having a copy generating limiting code to inhibit copying of recorded television broadcast signal (see, for

example, Abstract at lines 5-8; col. 7, line 49-col. 8, line 14; col. 8, lines 32-37; and FIG. 9 of Oguro). Depending on the copy generating limiting code, Oguro's VTR can freely copy, copy only once, or not copy at all (see for example, the copy generation limiting signals (SCMS) codes of col. 8, lines 1-7 of Oguro). Oguro is completely silent as to anything that virtually deletes a still picture or additional audio parts. Accordingly, Oguro fails to disclose each and every feature of claim 1, and claim 1 is distinguishable over Oguro. Withdrawal of the rejection is respectfully requested.

NEW CLAIMS:

Added dependent claims 4-7 are also distinguishable over the applied reference to Oguro for at least the reasons discussed above and for the additional features they recite.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 11/22/2006

By: Seth S. Kim
Seth S. Kim
Registration No. 54,577

1400 Eye St., NW

Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510